

## REMARKS

Claims 1-6 and 10-17 were pending in the application.

Claims 7-9 and 18-21 are withdrawn from consideration.

Claims 1-6 and 10-17 are rejected.

Claims 22-23 are new.

Claims 1, 9 and 10 are amended.

Claims 1-6 and 10-17 and 22-23 are now pending.

## **Restriction Requirement**

Applicants affirm the election of Group I made on June 20, 2005 by Shiela Loggins.

However, the Applicants traverse the requirement for the following reason:

All the elements of claim 1 are present in claims 7 and 8. All the elements in claim 22 are present in claims 9, 20 and 21. All the elements present in claim 10 are present in claims 18 and 19. Thus should claims 1-6, 10-17 and 22-23 be allowed, the claims of Group II should also be allowable.

The Examiner has failed to establish that it would be a serious burden to examine the entire application. See MPEP § 803. Indeed, from the search required for Group I, it appears to that very little additional burden would be required. It is respectfully noted that a mere difference in classification is not an appropriate basis for restriction. The classification system was set up for purposes of information retrieval (35 U.S.C. § 9), and not for the purpose of establishing the propriety of a restriction requirement (35 U.S.C. § 121).

Therefore Applicants will request rejoicing of claims 7-9 and 18-21 upon allowance of claims 1-6 and 10-17. This should be advantageous to the Office as well as the present Applicants as the rejoicing will save resources for both parties.

## **Amendments to Claims 1 and 10 and New Claims 22 and 23**

Claim 1 is amended to require a color granule size ranging from 100 to 500  $\mu\text{m}$ .

Support for this amendment may be found on page 7, paragraph 3 of the disclosure.

Claim 10 is amended to read:

A paint composition comprising a water-based paint system having an aqueous phase containing a dispersed pigment and colorant granules, wherein the colorant granules do not dissolve in the aqueous phase and the colorant granules upon rupture cause a color burst different than the color of the dispersed pigment (faux effect).

Support for this amendment may be found on page 2, paragraph 1 and page 7, last paragraph continuing onto the first paragraph of page 8 of the disclosure. In particular the aqueous phase must contain colorant granules that do not dissolve in the aqueous phase and when the granules are ruptured cause a burst of color or faux effect. Thus the dispersed pigment in the aqueous phase and the burst of color from the ruptured colorant granules must be different.

Also Applicants point to Example 2, page 8. This example describes the application of a base paint containing the color granules. When first applied the only visible color is that of the base paint. When shear is applied to the coating the color of the granule is exposed. This faux effect would not be possible unless the colorant of the granule be different from that of the base paint.

New claim 22 is supported by original claim 14 and withdrawn claim 8.

New claim 23 dependent on claim 22 is supported by the disclosure on page 7, first line of last paragraph.

Withdrawn claim 9 is amended to conform with claim 22.

No new matter is added.

### **35 USC 102 (b)**

Claims 1-4, 6, 10-12, 15 and 17 are rejected under 35 USC 102(b) as being anticipated by Kershaw et al US 5,839,253.

Claim 1 is amended to require the color granules range from 100 to 500  $\mu\text{m}$ .

Claim 10 is amended as explained above.

Both claims are not anticipated by Kershaw for the following reasons.

In regard to claim 1:

Kershaw exemplifies and discloses only granules of pigments which have a diameter varying from 1 to 50  $\mu\text{m}$ . See abstract, column 1, line 63, Tables 5 and claim 1. In particular column 3, line 21 states "we require that the granules be essentially of from 1-50 micron Stokes diameter...".

In contrast, the color granules of the present invention are at least twice the size of those disclosed by Kershaw.

Thus Applicants aver that Kershaw does not anticipate claim 1 or any of the claims dependent thereto.

In regard to claim 10:

Kershaw is concerned with providing dry matte films of **uniform visual appearance** and good mar resistance. See column 1, lines 46-47. Thus all the color granules of Kershaw contain color which is the same as the base coating (titanium oxide). See examples 1-8.

The amended claim 10 requires that the colorant granules upon rupture cause a color burst different than the color of the dispersed pigment (faux effect).

In contrast the present invention is directed to granules containing a colorant **visually different** from the base paint to give a non-uniform or a faux effect upon rupture.

Thus the Applicants aver that claim 10 does not anticipate Kershaw.

Claims 1-6, 10-12 and 15-17 are rejected under 35 USC 102(b) as being anticipated by Creusen et al EP 1 277808.

EP 1 277 808 discloses pigment compositions comprising a pigment and urea-aldehyde resin.

However the Applicants remind the Examiner that claim 1 reads:

A paint composition comprising a **water-based** paint system having an **aqueous phase** with colorant granules that do not dissolve in the aqueous phase wherein the granules have a particle size within the range of 100 to 500  $\mu\text{m}$ .

There is nothing in EP '808 which exemplifies or discloses a water-based paint system. Nothing is said regarding an aqueous phase with colorant granules. All of the pigment compositions of examples of EP '808 are prepared in solvent paint (alkyd/melamine system). See examples 1-4.

As EP '808 does not mention a water-based paint system having an aqueous phase with colorant granules, EP '808 does not anticipate.

### **Novelty of new claims 22-23**

Furthermore the Applicants believe the new claims to also be novel. New claim 22 in particular claims

A paint composition comprising a water-based paint system having an aqueous phase with colorant granules that do not dissolve in the aqueous phase and the colorant granules upon rupture cause a discernible color and create a faux effect pattern when the paint system is applied to a surface.

Claim 23 is dependent on claim 22 thus contains all the limitations.

There is nothing in either Kershaw or EP '808 to suggest the incorporation of such a colorant granule in a water-based paint wherein the colorant of the granules upon rupture cause a discernible color creating a faux effect when the paint system is applied to a surface.

### **Double Patenting**

Claims 1-6 and 10-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 7 and 10 of US 6,734,231.

This rejection is respectfully traversed. Moreover, Applicants respectfully request reconsideration of this rejection as applied against the present claims.

The Examiner states that US 6,734, 231 teach similar compositions comprising a coloring agent and urea-aldehyde resin. Although US '231 may appear to encompass some of the present claims, this domination is not the determining factor.

The determining factor in deciding whether or not there is double patenting is the existence vel non of patentable difference between two sets of claims (*In re Borah*, 354 F.2d 1009, 148 USPQ 213).

Claims 1, 3-5 and 7 and 10 of US '231 do not require a water-based paint system wherein the colorant granules do not dissolve in the aqueous phase. The present claims do. Indeed the present invention delivers a special effect (faux effect) based on this water-based paint system. There is nothing in the claims of US '231 which would make obvious an entirely unique effect by the simple requirement of an aqueous phase wherein the granules are not soluble. Thus the present compositions are unobvious in light of claims 1, 3-5, 7 and 10 of US '231.

Reconsideration and withdrawal of the rejection of claims 1-6 and 10-17 is respectfully solicited in light of the remarks and amendments *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-6,10-17 and 22 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Sheila A. Loggins  
Agent for Applicants  
Reg. No. 56,221

Ciba Specialty Chemicals Corporation  
540 White Plains Road  
Tarrytown, New York 10591  
(914) 785-2768  
sal\22844.doc